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10/534,586	05/11/2005	Yukihiko Asano	740709-536	3399

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NIXON PEABODY, LLP  
401 9TH STREET, NW  
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WASHINGTON, DC 20004-2128

EXAMINER
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RAE, CHARLESWORTH E

ART UNIT	PAPER NUMBER
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1611

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02/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/534,586

Applicant(s)

ASANO ET AL.

Examiner

Charlesworth Rae

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/26/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's application filed 5/11/08 is acknowledged.

#### **Status of the Claims**

Claims 1-6 are currently pending in this application.

#### **Priority**

Receipt of a certified copy of the non-English foreign priority application is acknowledged and made of record. The effective file date of the instant application is considered to be 11/14/03. Applicant is advised to submit an English certified copy of the foreign priority application in order to perfect the claim of benefit to the foreign application filing date of 11/14/02.

#### **Claim rejections – 35 USC 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 are rejected under 102(e) as being anticipated by Babler (US Patent 6,800,127).

No patentable weight is being given to the intended use of the claimed composition.

For purposes of this rejection, the term "[a] cosmetic composition comprising a cosmetic base selected from the group consisting of liquid base, paste base and powder base, a perfume ingredient and polyamide particles wherein the polyamide particles comprise spherical porous polyamide particles having ..." as recited in claims 1, and 4, given its broadest reasonable possible interpretation, is construed to mean a cosmetic base selected from the group consisting of a liquid base, paste base and powder base, a perfume ingredient and polyamide particles."

Babler (US Patent 6,800,127) teaches pigment preparation comprising polyamide particles having an average particle size below 50 microns and to 1 to 45 parts by weight of a pigment absorbed on or therein, wherein the parts by weight of the polyamide particles and pigment total 100 parts by weight (see reference claim 1). Instant claim 1 recite the term "polyamide particles." Babler teaches that the pigment preparations comprising a pigment polyamide particulate material are generally used in the form of a powder, which is incorporated into the substrate to be pigmented; the preparations further comprise suitable auxiliary agents e.g. anionic, cationic, non-ionic surface active agents (col. 3, line 36 to col. 4, line 40; and col. 5, line 14 to 7, line 65). Babler teaches ultra fine polyamide powder (col. 1, lines 54-57). Instant claim 1 recites the term "powder base." Babler exemplify a spherical porous polyamide-12 filler, average size of 2 to 8 micron (col. 9). Babler also teaches that the particle sizes and particle size distributions of the polyamide fillers is determined in accordance with the Principle of Fraunhofer light diffraction (col. 8, line 60 to col. 9, line 3). Instant claim 1

recites the term "polyamide comprise spherical porous polyamide particles having a number average particle diameter of 1 to 30 microns," which overlaps with the teaching of Babler of polyamide particles of average size of 2 to 8 microns (col. 9, especially Example 1).

The term "particles having ..., a BET specific surface area of 5 m<sup>2</sup>/g or larger, a crystallinity as measured by DSC of 40% or higher, and a ratio of volume average particle diameter/number average particle diameter of 1.0 to 1.5" as recited in claim 1; the term "wherein the BET surface area of the porous polyamide particles is 8 m<sup>2</sup>/g or larger" as recited in claim 2; the term "wherein the boiled linseed oil absorption of the porous polyamide particles is 240 mL/100 g or larger" as recited in claim 3; the term "particles having a number average particle length of 0.5 to 25  $\mu$ m, a ratio particle length/particle width of 3 to 50, a BET specific surface area of 5 m<sup>2</sup>/g or larger, ..., and a crystallinity as measured by DSC of 40 % or higher" as recited in claim 4, the term "wherein the BET surface area of the porous polyamide particles is 8 m<sup>2</sup>/g or larger" as recited in claim 5; and the term "wherein the boiled linseed oil absorption of the porous polyamide particles is 240 mL/100 g or larger" as recited in claim 6 are construed to be inherent properties of the composition.

Babler teaches porous polyamide particles in the form of a "gypsum rose," whose geometric shapes vary between the conical and pyramidal shapes, wherein the apices of the geometric forms are directed toward the center of the particle (col. 3, line 65 to col. 4, line 14). The term "wherein the polyamide particles comprise cylindrical or dumbbell shaped porous polyamide particles," given its broadest reasonable possible

interpretation is construed to overlap with the "gypsum rose" shaped particles taught by Babler (col. 3, line 65 to col. 4, line 14).

Thus, for the above reasons claims 1-6 are found to be anticipated by the cited prior art.

### **Claim rejections – 35 USC 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 USC 102(b) as being anticipated by Hillaire et al. (US Patent 4,831,061; **already made of record by applicant**) for the same reasons delineated in connection with the rejection above rejection under 102(e).

Hillaire et al. teach a process for manufacturing a polyamide powder formed by porous spheroidal elementary particles having a "gypsum rose" structure, having a mean diameter between 1 and 20 microns (col. 1, lines 7-63); instant claim 1 recites the term "average particle diameter of 1 to 30  $\mu\text{m}$ ". Hillaire et al. teach that the cavities of the particles resemble cylinders (col. 1, line 67 to col. 2, line 2). Hillaire et al. teach that the absorption characteristics is of particlaur interest in the area of cosmetics (e.g. beauty powders), analgesics, pharmaceuticals, microencapsulation etc. (col. 2, lines 19-34). Hillaire et al. teach linseed oil absorption ranging between 170 and 220 wt. % (see

cols. 5-7, Examples 1-6), which overlaps with the instant claimed linseed oil absorption limitations ranging from 200 wt. % (i.e. claims 1 and 4) to 240 wt. % (i.e. claims 3 and 6). Hillaire et al. teach BET specific surface between  $9.3 \text{ m}^2/\text{g}$  and  $9.9 \text{ m}^2/\text{g}$  (cols. 5-7, Examples 1-6), which overlaps with the claimed BET specific surface recited in claims 1, 2, 4, and 5 (i.e.  $5 \text{ m}^2/\text{g}$  or larger,  $8 \text{ m}^2/\text{g}$  or larger,  $5 \text{ m}^2/\text{g}$  or larger, and  $8 \text{ m}^2/\text{g}$  or larger, respectively) .

The claim limitations as discussed above in connection with the rejection under 102(e) with respect to crystallinity, particle length/particle width, ratio of volume average particle diameter/number average particle diameter are construed to be inherent characteristics of the claimed composition.

Thus, claims 1-6 are found to be anticipated.

#### **Claim rejections – 35 USC 103(a)**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babler (US Patent 6,800, 127) in view of Bui-Bertrand et al. (5,690,945) or Hillaire et al., in view of Bui-Bertrand et al. (5,690,945).

The above discussions of Babler and Hillaire et al. in connection with the rejections under 102 are incorporated by reference.

Neither Babler nor Hillaire et al. teach a cosmetic composition comprising a cosmetic base, a perfume ingredient, and polyamide particles as claimed.

Bui-Bertrand et al. teach a cosmetic skin-cleanings mask composition which contains, as its principal cleansing constituent, graded or calibrated spheroidal polyamide particles which are dispersed in an aqueous gel, wherein the particles are present in an amount greater or equal to 12 % by weight relative to the total weight of the composition, and wherein the composition may also contain additional water-soluble or water-solubilized ingredients which are conventionally used in cosmetic compositions e.g. fragrances (abstract and col. 3, line 64 to col. 4, line 10; see also Examples 1-4, cols. 4-5).

Based on the teaching of Bui-Bertrand et al. of cosmetic compositions comprising conventional cosmetic ingredients e.g. fragrances, and spheroidal polyamide particles in an aqueous gel (= equivalent of a base), someone of skill in the art would be motivated to combine the cited reference teachings of Babler and Bui-Bertrand et al. or Hillaire et al. and Bui-Bertrand et al. to create the instant claimed inventive concept.

Thus, someone of skill in the art at the time the instant invention was made would have found it obvious to create the instant claimed invention with reasonable predictability.

**Claim rejections – 35 USC 112 – Second Paragraph**

The following is a quotation of the second paragraph of 35 USC 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the terms " 5 m2/g or larger," "absorption of 200 mL/100 g or larger" and "DSC of 40% or higher" which renders the claimed subject matter vague and indefinite because the metes and bounds of the terms are rendered unclear by the recitation of the terms "or larger" and "or higher."

Claims 2, 3, 4, 5, and 6 are rejected for the same reasons for reciting one or more of said terms.

Claim 4 recites the term "width of 3 to 50." This term renders the claimed subject indefinite as it is not clear what units of measure is being referred to.

**Relevant Art of Record**

The below cited references made of record and relied upon is considered pertinent to applicant's invention.

Vatter (US Patent Application Pub. No. 2002/0015684) teach cosmetic make-up for topical application to the skin containing liquid base materials (para 070); suitable solidifying agents (e.g. waxy materials, fatty acids having from 12 to 22 carbon atoms, amides of higher fatty acids) to solidify the particular liquid base materials (para 0071). Vatter teaches organic powders/fillers, including polymeric particles such as methylsilsesquioxane resin micropsheres, microspheres of polymethylmethacrylates, and spherical particles of crosslinked polydimethylsiloxanes,; spherical particles of polyamide, and more specifically Nylon 12 (para 0079; and para 0096). Vatter teaches that pigment and/or dye encapsulates are also useful (para 0080). Vatter teaches a method for determining particle size (para 0105 to 0106).

Jenkins et al. (US patent 5,919,467) teach cosmetic compositions in the form of powder comprising branched chain aliphatic hydrocarbon having a weight average molecular weight of from about 100 to about 15,000 and the remainder of the composition comprising one or more cosmetic powder base components selected from pigments, matter finishing agents, fillers and binders, and mixtures thereof (abstract). Jenkins et al. teach porous hydrophobic polymeric particles having a surface area ( $n_2$ -BET) in the range from about 50 to 500, preferably 100 to 300  $m^2/g$  and having the active ingredient absorbed therein (col. 4, lines 33-44). Jenkins et al. teach that the system of powder particles forms a lattice which includes unit particles of less than about one micron in average diameter, agglomerates of fused unit particles of sized in the range of about 20 to 100 microns in average diameter and aggregates of clusters of

fused agglomerates of sizes in the range of about 200 to 1,200 microns in average diameter (col. 4, lines 45-57). Jenkins et al teach optional ingredients can be included in the composition e.g. preservatives, fragrances, sunscreens, chelating agents, vitamins, and moisturizing agents (col. 5, lines 53-63).

Davis et al. (US Patent 6,071,996) teach walkway pad containing polymer compounds (e.g. EPDM, and Zeolex) having a BET surface area of about 75 m<sup>2</sup>/g, a refractive index at 20 degrees C. of about 1.51, and a pH of about 10.2; the average particle size, density, physical form and oil absorption properties are similar to each other ( col. 5, line 9 to col. 11, line 24). Davis et al. teach that typical EPDM terpolymers having less than 2 weight percent crystallinity are commercially available (coil. 6, lines 8-17); EPDM terpolymers having more than 2 percent crystallinity from the ethylene component are also disclosed (col. 6, lines 35-52).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlesworth Rae whose telephone number is 571-272-6029. The examiner can normally be reached between 9 a.m. to 5:30 p.m. Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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29 January 2008  
CER

BRIAN-YONG S. KWON  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'B. Kwon', written over a horizontal line.